

02/28/01

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 74  
BAC

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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**Educational Testing Service**

v.

Training & Development Corporation

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Opposition No. 94,153  
to application Serial No. 74/366,710  
filed on **March 10, 1993**

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**Lile H. Deinard** of Dorsey & Whitney LLP for **Educational Testing Service.**

**Thomas L. Bohan** of **Thomas L. Bohan & Associates** for Training & Development Corporation.

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Before **Walters, Chapman and Bottorff**, Administrative Trademark Judges.

Opinion by **Chapman**, Administrative Trademark Judge:

An application has been filed by Training & Development Corporation to register on the Principal Register the mark shown below

for "computer-based software for use by educators, trainers and social service providers to integrate services delivery, and to monitor and evaluate the status, progress and

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performance of individuals, programs and enterprises." The application is based on applicant's assertion of a bona fide intention to use the mark in commerce. Applicant included the following statement in its application: "The mark consists, in part, of the Greek letter Y (Xi), which is the fourth letter of the term PRAYIS in applicant's mark." Applicant disclaimed the words "Personal Records Access and Information System."

In its amended notice of opposition<sup>1</sup>, Educational Testing Service alleges that it is the owner of three registrations, one for the mark THE PRAXIS SERIES: PROFESSIONAL ASSESSMENTS FOR BEGINNING TEACHERS (Reg. No. 1,772,125),<sup>2</sup> and the two marks shown below

Reg. No. 1,772,128

Reg. No. 1,812,590

all for "computer programs in the field of test development, test administration and test scoring for teacher examinations" in International Class 9, "printed test forms

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<sup>1</sup> Opposer's motion to amend its notice of opposition was granted by Board order dated March 27, 1996.

<sup>2</sup> The American Heritage Dictionary defines "praxis" as "n. 1. Practical application or exercise of a branch of learning. 2. Habitual or established practice; custom." The Board may take judicial notice of dictionary definitions. See TBMP §712.01. (See also, opposer's Exhibit 14, p. 3.)

and test form answer sheets, printed booklets and instructional manuals for teacher examinations" in International Class 16,<sup>3</sup> and "test development, test administration and test scoring services for a series of teacher examinations, performing research and validity studies with respect to teacher examinations" in International Class 42;<sup>4</sup> that since prior to the filing date of applicant's application opposer has continuously used the mark THE PRAXIS SERIES: PROFESSIONAL ASSESSMENTS FOR BEGINNING TEACHERS for its proficiency assessment printed materials and related services and for its computer programs relating to its assessment and evaluation services; and that applicant's mark so resembles opposer's previously used and registered marks, if used on applicant's identified goods, would be likely to cause confusion or mistake or to deceive.

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<sup>3</sup> The wording of the International Class 16 goods differs in order, but not in substance as to the International Class 16 goods covered by each registration.

<sup>4</sup> Registration No. 1,772,125, issued May 18, 1993; Section 8 affidavit accepted.

Registration No. 1,772,128, issued May 18, 1993; Section 8 affidavit accepted. This registration includes a statement that the drawing is lined for the color blue.

Registration No. 1,812,590, issued December 21, 1993; Section 8 affidavit accepted.

The words "series" and "professional assessments for beginning teachers" are disclaimed in each registration.

The claimed date of first use is September 25, 1991 for the International Class 9 goods, June 23, 1991 for the International Class 16 goods, and June 23, 1991 for the International Class 42 services in each registration.

In its amended answer with counterclaims<sup>5</sup>, applicant/petitioner (hereinafter applicant) admits that opposer/respondent (hereinafter opposer) is the owner of its three pleaded registrations; that the dominant feature of applicant's mark is the word PRAYIS; and that "the term 'PRAYIS' in Applicant's mark resembles in appearance the term 'PRAXIS' in Opposer's registered mark," but specifically denies that the term PRAXIS is the dominant feature of opposer's registered marks. Applicant denies the remaining salient allegations of the amended notice of opposition.<sup>6</sup> Also, applicant counterclaimed to cancel the International Class 9 goods in each of opposer's three pleaded registrations essentially on the basis that opposer does not use the involved marks in commerce on computer programs.

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<sup>5</sup> Applicant's motion to amend its answer was granted by Board order dated August 24, 1998.

<sup>6</sup> On March 27, 1996, the Board, inter alia, denied both parties' motions for summary judgment on the issue of likelihood of confusion. In footnote 4 of that order, the Board referred to the inconsistency in applicant's admission that the dominant feature of applicant's mark closely resembles in sound, appearance and connotation the dominant feature in opposer's mark in light of other denials in applicant's answer; and the Board stated that "we are treating applicant's answer to include a denial of this paragraph" (Paragraph 12 of the original notice of opposition). Subsequent to that Board order applicant has filed an answer to the amended notice of opposition, as well as an amended answer with counterclaims. In both documents applicant admits opposer's allegation (now paragraph 19) that the term PRAYIS in applicant's mark resembles in appearance the term PRAXIS in opposer's mark. This is now clearly an admission by applicant as to the similarity in appearance of the words PRAYIS and PRAXIS.

Opposer, in its answer to the counterclaim, denies the salient allegations thereof.<sup>7</sup>

The record consists of the amended pleadings; the files of the opposed application and of the registrations sought to be cancelled; trial testimony, with exhibits, taken by each party; notices of reliance filed by each party; and rebuttal testimony and evidence taken and filed by opposer.

Both parties filed briefs on the case, but neither party filed a supplemental brief (as explained in footnote 7, *supra*). An oral hearing was not requested.

### **Evidentiary Matters**

Preliminarily, we will address each party's objections to various matters in the record. First, in opposer's brief on the case, in the section describing the record, opposer

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<sup>7</sup> Trial dates in the opposition had closed and the parties had filed their briefs on the case when, on August 24, 1998, the Board granted applicant's motion to amend its answer to include a counterclaim. The Board allowed opposer time to file an answer to the counterclaim, and counterclaim dates and supplemental briefing dates were set by the Board. In an order dated December 6, 1999, the Board (i) denied opposer's motion to dismiss the counterclaim under Fed. R. Civ. P. 12(b)(6)—holding that while the counterclaim is not a sufficient pleading of fraud under Fed. R. Civ. P. 9(b), the pleading does include a sufficient pleading that opposer does not use its marks on computer programs (International Class 9 goods); (ii) denied opposer's motion for summary judgment on the counterclaim, including a lengthy discussion that the issue raised by applicant's counterclaim is whether the use of opposer's mark on computer programs constitutes use of the mark on separate goods in trade; (iii) reset opposer's time to answer the counterclaim; and (iv) reset the expedited counterclaim trial and supplemental briefing schedule. Opposer filed its answer to the counterclaim, but

referred to "Applicant's 'Response' Notices of Reliance 'Upon Further Portions' of [discovery depositions of and discovery responses by applicant] Which the Board May, in its Discretion, Refuse to Consider under 37 C.F.R.

§2.120(j)(4)." This objection is moot as to the Marc Tucker deposition because the entire deposition was later submitted by opposer. As to the remaining four "response" notices of reliance filed by applicant, opposer made no clear and specific objection, and did not file a motion to strike these notices of reliance. Thus, the Board, in its discretion, has considered applicant's "response" notices of reliance.

Next, in its reply brief, (i) opposer moved to strike pages 9-11 and 22-23 of applicant's brief (relating to third-party uses and/or registrations); and (ii) opposer requested (on page 11) that "so much of Applicant's Brief as consists of argument in support of cancellation of Opposer's pleaded registrations in Class 9 on alleged grounds of non-use should be stricken." Opposer's motion to strike specific pages of applicant's brief, as well as opposer's request to strike non-specific portions of applicant's brief, are both denied. The Board does not generally strike arguments in a brief, but we will consider a party's

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neither party submitted any further trial evidence, or any supplemental briefs.

objections and any improper portion(s) of a brief will be disregarded. See TBMP §540.

Applicant (on pages 31-33 of its brief) objected to opposer's September 25, 1997 rebuttal notice of reliance on printed publications under Trademark Rule 2.122(e) on the basis that they are "irrelevant and immaterial" and "unpersuasive." (A photocopy of this notice of reliance was attached as Exhibit 50 to opposer's brief.) Because applicant's objections to opposer's September 25, 1997 notice of reliance, in essence, relate more to the probative value of the evidence than to the admissibility thereof, the objections are overruled. See TBMP §708, and cases cited therein.<sup>8</sup>

Finally, on pages 20-21 of its brief, applicant stated that during the June 10, 1997 testimony deposition of Paul A. Ramsey, Ph.D., applicant "objected to entry in the record of what [opposer] in its Final Brief has identified as Exhibits 41, 42, 43 and offered during Mr. Ramsey's testimony as Opposer's Exhibits 2, 3, 7, 8, 9, 17, 29, 30, 33 and 36, on the grounds of hearsay, or for a lack of foundation in the witness through which those exhibits were offered, or a combination of the two"; and that applicant

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<sup>8</sup> On page 21 of applicant's brief, applicant appears to object to opposer's September 25, 1997 notice of reliance on printed publications on the ground that it is improper rebuttal. We disagree and this objection is overruled.

"repeats and re-asserts its objection to the entry of those exhibits and moves the Board to deny their entry."

The exhibits attached to opposer's brief as Exhibits 41-43 correspond only with opposer's Exhibits 7-9 offered at the June 10, 1997 Ramsey deposition. Whether applicant intended only testimony Exhibits 7-9, or all of those enumerated above, upon our review of the June 10, 1997 Ramsey deposition, we overrule applicant's objections. During the course of the deposition, this witness offered testimony which provides sufficient foundation regarding the involved matters. As to applicant's hearsay objection, we find that, in the context of Dr. Ramsey's testimony, this is not well taken.

Applicant's objections to evidence, opposer's comment on applicant's "response" notices of reliance, and opposer's motion and request to strike have been denied, but we hasten to add that the Board has considered the evidence or arguments only for appropriate purposes. As a final point, we would add that even if the involved testimony and evidence were excluded, we would reach the same result on the merits of this case.

### **The Parties**

Educational Testing Service (opposer), a non-profit organization, was founded in 1947 to create assessment



systems independent of particular curricula. Opposer offers various tests such as the SAT and the GRE. Opposer's THE PRAXIS SERIES program, designed to replace its National Teacher Examination (NTE), is a licensing examination for beginning teachers, which consists of three parts or assessments, namely, PRAXIS I - a test of the potential teacher's basic skills of reading, writing and mathematics (which can be taken either on a computer or in paper and pencil format); PRAXIS II - a test of the potential teacher's knowledge of the subject area he or she is going to teach, such as math, English, history, and the like (taken in paper and pencil format); and PRAXIS III - an observation evaluation in the classroom of the teaching skills of the beginning teacher.

Initial research and development of THE PRAXIS SERIES tests began in 1987, with field testing, involving thousands of teachers and students, beginning in January 1991 for PRAXIS III evaluations, in June 1991 for PRAXIS II tests and in September 1991 for PRAXIS I tests. Opposer formally launched THE PRAXIS SERIES testing program in spring 1992; this program being the largest development activity ever undertaken by opposer, with opposer investing between \$45 and \$60 million in its development.<sup>9</sup> Opposer's use of its

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<sup>9</sup> Both opposer and applicant submitted portions of the record under seal as "confidential." However, in the briefs on the case, the parties specifically referred to various portions of

registered THE PRAXIS SERIES marks has been continuous since 1991.

Opposer also has used and has established common law rights in the marks PRAXIS I, PRAXIS II, and PRAXIS III, and the word PRAXIS alone, as trademarks and as service marks, with continuous use since May 1992. There is clear evidence of such use throughout opposer's brochures, advertising, and other marketing materials. (See, e.g., opposer's Exhibits 5, 6, 10, 17, 21, 40 and 41, and the related testimony of Dr. Paul Ramsey, opposer's vice-president for School and College Services.)

According to Dr. Ramsey, approximately 48 states require teacher assessment examinations, and currently 34 states and the District of Columbia use opposer's testing program for teacher licensing and certification.<sup>10</sup> In the states that have adopted opposer's THE PRAXIS SERIES testing program, the PRAXIS II tests (which assess the test-taker's knowledge of the specific subject he or she will teach), are also required of school guidance counselors, administrators, social workers, psychologists, special education teachers, vocational teachers, and others. THE PRAXIS SERIES tests

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said "confidential" record. Thus, the parties have waived "confidentiality" as to those matters.

<sup>10</sup> Dr. Ramsey acknowledged that many of the 34 states utilizing opposer's teacher examination originally required opposer's previous test known as the National Teachers Examination, but he explained that all such tests are now under the rubric of opposer's THE PRAXIS SERIES program.

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are given throughout the entire United States (including all 50 states) on college campuses, at opposer's regional offices, and at Sylvan Learning Centers.

Opposer markets, demonstrates and advertises this testing program at educational conferences, trade shows and seminars, involving groups such as NEA (National Education Association), AACTE (American Association of Colleges for Teacher Education), NCSL (National Conference of State Legislators), HACU (Hispanic Association of Colleges and Universities), NMSA (National Middle School Association), California Department of Education, NASDTEC (National Association of State Directors of Teacher Education and Certification), NASSP (National Association of Secondary School Principals), NSTA (National Science Teachers Association), and NCTM (National Council for Teachers of Math). Both applicant and opposer are exhibitors at the American Vocational Association's conventions. (See opposer's Exhibit 29.)

Opposer distributes information regarding THE PRAXIS SERIES tests to colleges and universities (deans of education), teachers in schools of education, government agencies (state departments of education), and various education leaders. Approximately 14 million publications pertaining to opposer's THE PRAXIS SERIES program have been distributed between 1991 and 1997. Total marketing costs

are in the hundreds of thousands of dollars per year (nearing or exceeding \$1 million dollars in 1997), with the printing of test booklets and production costs being an additional few million dollars in costs annually.

Annual revenues from opposer's THE PRAXIS SERIES testing program have amounted to tens of millions of dollars per year since the early and mid-nineties. Approximately one and one-half million THE PRAXIS SERIES tests have been given to one million test-takers.

Training & Development Corporation (applicant), also a not-for-profit corporation, runs career advancement centers and job corps centers, the end users of which "are individuals directly involved in transitioning from school to work, from welfare to work, from job to job or endeavoring to advance in a job." (July 30, 1997 Charles G. Tetro--applicant's president and CEO--dep., p. 5.) More specifically, applicant's job training programs (in Maine and Virginia) are employment training programs for unemployed and economically disadvantaged individuals seeking to return to the employment market, and applicant provides "a variety of employment assessment, career development services, including occupational training, basic skills training, job search and job placement services." (Jon Robert Farley--applicant's vice-president for career advancement services--dep., p. 2.)

Applicant has not yet used its applied-for mark on the computer software identified in its application, and in fact, applicant has made a business decision to put its marketing and funding plans on hold pending the result of this challenge to its application. Applicant testified through, among others, Charles G. Tetro, that its new computer program to be sold under the applied-for mark is intended to be "a next generation of a case management system, a successor to [applicant's Automated Case Management System or ACMS]," with a major difference being that the customers themselves will self-manage their activity and data rather than as is currently done through the professional staff for ACMS.<sup>11</sup> (August 30, 1996, Tetro dep., p. 8.)

Applicant's involved goods will be "targeted initially to the education sector then to welfare"; applicant "will mount a national Praxis project for education...."; and its "Personal Records Access and Information System would be sold to schools..." (August 30, 1996 Tetro dep., pp. 12, 13, 45).

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<sup>11</sup> Applicant's Automated Case Management System (ACMS) has been marketed to educational institutions. (August 30, 1996 Charles G. Tetro dep., p. 33.)

**Applicant's Counterclaim**

In its counterclaim to cancel the International Class 9 goods ("computer programs in the field of test development, test administration and test scoring for teacher examinations") from each of opposer's three pleaded registrations, applicant pleaded that opposer does not use its mark in commerce for computer goods. In its brief on the case applicant argued that there has been no use of opposer's relied-upon marks in commerce for computer software goods; that individuals being tested cannot take the examination software away from the examination; and that "such a lack of characteristic sale of Class 9 goods indicates no use of [opposer's] marks at issue in commerce for such goods." (Brief, p. 28.)

Opposer argues in its reply brief that its PRAXIS I test "is accessed (and interacted with) by test-takers via a computer by means of software licensed to Opposer's test administrators, whether commercial or educational in nature, and delivered by Opposer to them in interstate commerce" (p. 9).

Further, opposer argues that according to the legislative history of the Trademark Law Revision Act of 1988 regarding the Section 45 amended definition of "Use in Commerce" as "bona fide use of a mark in the ordinary course of trade..." is to be **"interpreted to mean commercial use**

which is typical in a particular industry," and "the definition should be interpreted with flexibility so as to encompass various genuine, but less traditional, trademark uses..." (Reply brief, pp. 9-10, emphasis in original.)

Opposer then argues as follows (reply brief, p. 10):

This statement of legislative intent expressly identifies uses such as Opposer's as constituting "use in commerce," and highlights the fundamental flaw in Applicant's position on this issue. While Applicant would have the Board focus exclusively on whether purchasers get something "tangible," the drafters of the Lanham Act revisions urge that industry practice be considered. Applicant is no doubt well aware that consumers who "purchase" computer software for their home computers in retail outlets are actually getting a license to use the underlying computer program, subject to certain terms and conditions. Similarly, purchasers of Opposer's PRAXIS SERIES software do not always walk away with a disk, but they certainly pay for a license to use Opposer's software and interact continuously with the PRAXIS I computer program.

And, of course Opposer's PRAXIS software is delivered to test centers in interstate commerce and has been thus delivered from the inception of Opposer's pilot testing in September 1991.

As was made clear by the Board in our previous order dated December 6, 1999, the only issue before us in applicant's counterclaim is whether applicant has established that opposer does not use its mark on computer

software as separate goods in trade, and thus, that its registrations should be cancelled as to International Class 9.

Applicant, as plaintiff in the counterclaim, bears the burden of proving, by a preponderance of the evidence, its asserted ground of opposer's non-use of its mark on computer software. See *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989). On this record we cannot find that applicant has met its burden.

The Trademark Law Revision Act (TLRA) amended, in relevant part, the definition of "use in commerce" by adding the following initial sentence: "The term 'use in commerce' means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a mark." The legislative history of the TLRA reveals that a major purpose of this amendment was to eliminate "token use" as a basis for registration, and that a related intent was that the stricter standard contemplates instead commercial use of the type common to the particular industry in question. See *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1774 (TTAB 1994).

Opposer's previous teacher certification test (the National Teachers Examination or NTE) had no component delivered by a computer, whereas opposer's THE PRAXIS



SERIES, and particularly PRAXIS I, provides the option of taking this test via computer, and it is a "computer adaptive test," which is used because one does not want to test the person's computer skills, but rather their skills in the subject(s) of the test. (June 10, 1997 Ramsey dep., p. 21).<sup>12</sup> Opposer distributes preparatory booklets titled "Tests at a Glance" (TAAGs) for PRAXIS I as well as for each subject under the PRAXIS II tests (opposer's Exhibits 5, and 23-26). It also distributes a tutorial booklet to show the test-taker how to take the PRAXIS I test by computer (opposer's Exhibit 21-A), which gives instructional sequences, provides sample questions, and shows reprints of computer screens (some of which include the word PRAXIS thereon).<sup>13</sup>

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<sup>12</sup> The number of students opting to take opposer's PRAXIS I test as a computer-based test has increased since the test's inception in 1991.

<sup>13</sup> In addition, as a result of a request from a group of historically black colleges and universities for more help in preparing their students to take the PRAXIS I test, opposer created the "Learning Plus" program in September 1993. This is a non-secured preparatory examination for the PRAXIS I examination. The purchase order form for opposer's "Learning Plus" program includes a statement that this software is a computer-based instructional product developed for The Praxis Series and that the order form is the purchaser's request for a license to use the involved proprietary software. Also, the form includes software charges for both a "one time site license fee" and a "student user fee" which varies depending on the number of students. (Opposer's Exhibit 31-A.) There are currently several hundred of these site licenses, about 10% of which are used in vocational schools. (In May 1996, applicant purchased "Learning Plus" software from opposer for use at applicant's summer youth program and for adults who need to upgrade their basic skills in order to obtain a job.)

It is a heavily contested point between the parties as to whether opposer uses the mark PRAXIS, PRAXIS I or THE PRAXIS

When opposer sells its PRAXIS I test (the basic test of reading, writing and mathematics skills), states contract with opposer to give the test, and the test-takers come in and take a secured test (one given under standardized conditions with opposer or its agents attending as monitors), and they later receive a score report. (June 10, 1997 Ramsey dep., p. 138-140.) That is, states determine if they will give opposer a contract to administer the teacher licensing examinations in that state, and the students individually pay to take the test. On cross examination by applicant's attorney, Dr. Paul Ramsey explained the sale of its testing services and its printed materials and computer products as follows (June 10, 1997 dep., pp. 142-143):

Q. So there is no exchange of money between ETS and the state entities?

A. As a general rule, there is not. There might be some special work they want you to do and they would pay for that. Like, maybe they would want a special kind of a report. But as a general rule, you make up the work through student test-taking fees.

Q. Then you don't provide any type of computer software to the states regarding these tests, then, do you?

A. We provide disks with student scores on them. We provide, you know, secured testing centers that have in Praxis I the computer-based test on it.

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SERIES in connection with "Learning Plus." While the word PRAXIS does not appear on the "Learning Plus" program CD labels or on the video cassette labels, there is evidence that the marks are sometimes used together in promotional materials. (See, e.g., opposer's Exhibit 45.) However, we need not rely on opposer's use of its mark "Learning Plus" in order to determine this case.

On direct examination by applicant's attorney, Dr. Paul Ramsey again explained the sales involved as follows (July 28, 1997 dep., pp. 22-23):

Q. When a student or a test-taker takes the Praxis Series Professional Assessment for Beginning Teachers Examination on a computer, do they have access to the software itself?  
(objection discussion omitted)  
A. If you're taking the test, you have access to the software.

The record clearly shows that opposer pilot tested its PRAXIS I software in September 1991 and it has been in continuous use since that time. Opposer transfers the computer software to the test-taking sites, for example, schools and Sylvan Learning Centers, and the disks are returned to opposer. (September 17, 1997 Ramsey dep., pp. 35-36.) The fact that the computer software (or the printed test booklet) is returned to opposer for reading the test scores and to generate a report back to the state, the school and/or the student does not negate trademark use for those goods in this industry.

Applicant has not specifically identified why opposer's use is inappropriate or insufficient under the TLRA definition of "ordinary course of trade," especially as the evidence shows that site licensing, accompanied by computer software and/or printed booklets and test forms is characteristic in this academic testing industry. To whatever extent applicant intended to argue that in order

for adequate "use in commerce" under the Trademark Act, there must be a tangible and permanent transfer of goods, we disagree. Applicant cited to no case law and we find none to that effect. There is nothing in the TLRA amending the Section 45 definition of "use in commerce" which so states. In fact, the legislative history of this amendment was generally to the contrary, advocating that we look to the ordinary course of trade in each particular industry and take a flexible approach.

Opposer's registered design mark and its common law mark, PRAXIS, unquestionably appear on the labels of its computer software, and on printouts of computer screens. These are normal uses sufficient to establish use on computer programs for purposes of registration at the USPTO. Cf. *In re Shareholders Data Corporation*, 495 F.2d 1360, 181 USPQ 722 (CCPA 1974) (involving the court's affirmance of the Board's affirmance of the Examiner's refusal to register a mark for reports because they were not separate goods in trade; the Court noted that the basis of the statutory refusal was not specified by the Examiner or the Board, but the court interpreted it as based on Sections 2 and 45 of the Trademark Act; one judge dissented).

Opposer's PRAXIS I test is accessed via computer by means of licensed software which is delivered by opposer in

interstate commerce; licensing to test providers is the means of transfer that is customary in the field; opposer's PRAXIS I test is interacted with by test-takers; and PRAXIS and/or THE PRAXIS SERIES PROFESSIONAL ASSESSMENTS FOR BEGINNING TEACHERS (and design) appears on the label of the computer disks, as well as on numerous computer screens from the PRAXIS I test.

We find on this record that opposer sells teacher license/certification testing services and printed materials and computer software, as interpreted under the definition of "use in commerce" under Section 45 of the **Trademark Act**, and the legislative history of the TLRA related thereto. That is, in this academic testing industry such use on these goods is separate use on goods in trade. Accordingly, applicant's counterclaim is dismissed.

### **Opposer's Opposition -- Likelihood of Confusion**

Status and title copies of opposer's registrations of its pleaded registered marks are of record, and therefore, priority is not an issue.<sup>14</sup> See King Candy Company v.

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<sup>14</sup> Opposer's three pleaded registrations all issued in 1993. The status and title copies thereof submitted under a notice of reliance were prepared by the Patent and Trademark Office in January 1997, and thus, did not include information as to the Section 8 affidavits, which were due in 1999. The records of this Office indicate that opposer timely filed a Section 8 affidavit in each registration, and that said affidavits were accepted by the Office.

When a registration owned by a party has been properly made of record in an inter partes case, and there are changes in the

Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and Carl Karcher Enterprises Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125 (TTAB 1995). Moreover, the record establishes opposer's use of its marks prior to the filing date of applicant's application (March 10, 1993).

We turn then to the issue of likelihood of confusion. Our determination of likelihood of confusion must be based on our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Turning first to a consideration of the parties' respective goods and services, it has been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration(s). See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian*

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status of the registration between the time it was made of record and the time the case is decided, the Board will take judicial notice of, and rely upon, the current status of the registration as shown by the records of the Patent and Trademark Office. See TBMP §703.02(a), at page 700-10, and the cases cited therein. The Board hereby takes judicial notice of the current status of opposer's pleaded registrations.

Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Further, it is well settled that goods and/or services need not be identical or even competitive to support a finding of likelihood of confusion, it being sufficient instead that the goods and services are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992); and *In re International Telephone and Telegraph Corporation*, 197 USPQ 910 (TTAB 1978).

Applicant's computer software, as identified, is for use by, inter alia, "educators," and it is to "evaluate" the "performance of individuals." Opposer's computer programs, as identified, are specifically in the field of test development, administration and scoring for teacher examinations; and opposer's services are test development, administration and scoring for a series of teacher examinations, as well as performing research and validity studies of teacher examinations. While the computer software programs of applicant and opposer are not identical, it is clear that applicant's computer software, as identified, encompasses software for use in the education

field and for evaluation of individuals. That is, opposer's goods, as well as its services, specifically relate to teacher examinations, and applicant's goods specifically relate to educators and evaluations. Even if applicant's actual business involves only job market access (as distinguished from teacher licensing), applicant's identification of goods is not so restricted.

Applicant's identification of goods does specify that the software is intended "for use by educators, trainers and social service providers." The goods and services offered by opposer encompass these professional groups. See *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Applicant's argument that its goods would be directed specifically to a variety of social service agencies with a focus on moving people into the workforce, is unpersuasive in view of applicant's identification of goods. Also, inasmuch as applicant's mark has not yet been used, applicant's possible future marketing plans, (which, in any event, could be altered at any time before, during or after the commencement of use of the mark) are not relevant to our decision on the registrability of this mark.

Even if we assume, as argued by applicant, that the parties' customers and potential customers (for example,



state agencies) are sophisticated<sup>15</sup> and may exercise considerable care in selecting these goods and services, this does not mean that the consumers are immune from confusion as to the source of the goods and services offered by applicant and opposer. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

We find applicant's identified goods are related to opposer's teacher testing services as well as opposer's computer software; and that the parties' goods and services would be sold in similar channels of trade to the same purchasers.

We turn next to an analysis of the similarity as to sound, appearance, connotation and commercial impression between applicant's mark, \_\_\_\_\_, and opposer's registered and common law marks, all of which include the word PRAXIS.

Applicant admits that the dominant feature of its mark is the word PRAYIS; and in answering interrogatory No. 8, applicant stated that "The phonetic equivalent of that portion of our Mark including the phrase PRAYIS is the word praxis, pronounced 'prak-sis', as set out in the 1980 American Heritage Dictionary." However, applicant contends

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<sup>15</sup> We are hesitant, absent proof, to assume the certainty of applicant's argument regarding sophistication of state agency personnel as purchasers.

that PRAXIS is not the dominant feature of opposer's various marks, and that the overall marks are dissimilar. Clearly PRAXIS is the only word in opposer's common law mark, PRAXIS; and it is likewise clearly the dominant word in opposer's common law marks PRAXIS I, PRAXIS II, and PRAXIS III. With regard to opposer's registered marks which include other wording and two of which include a design feature, we still find that the word PRAXIS is the dominant source-indicating word in opposer's registered marks. All of the other words in both parties' respective marks are highly suggestive, if not descriptive, of the goods and services; and in fact, these words have been disclaimed. Also, both parties' marks include the word PRAXIS or PRAYIS as the first word or first portion of the marks. Thus, the words PRAXIS and PRAYIS are the dominant parts of the respective involved marks. See *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 19985).

Of course we consider the involved marks in their entirety, and when so considered, we find that applicant's mark is similar in sound, appearance, connotation and commercial impression to opposer's marks. Applicant admitted in its amended answer that the word PRAYIS in its mark resembles in appearance the word PRAXIS in opposer's marks. Applicant has also acknowledged that the word PRAYIS is pronounced like the word PRAXIS. Applicant's

word PRAYIS is comparable to the word PRAXIS, albeit using the letter "X" from the Greek alphabet.

The differences in the marks might not be recalled by purchasers seeing the marks at separate times. The emphasis in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered; that is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992); and *Edison Brothers Stores v. Brutting E.B. Sport-International*, 230 USPQ 530 (TTAB 1986).

While PRAXIS may be a suggestive term in the fields of educational testing materials and services, suggestive marks are entitled to protection, and the marks carry the same connotation for both opposer and applicant. In any event, the record is clear that opposer's marks including the word PRAXIS are strong marks, based on opposer's millions of dollars in development, millions of dollars in advertising and marketing, and its achievement of millions of dollars in revenues from THE PRAXIS SERIES goods and services in the several years it has been available.

Giving appropriate weight to all components of the involved marks, and considering the marks in their entirety, we find that these marks are similar in sound, appearance, connotation and commercial impression. See *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992); and *In re National Data*, supra.

Applicant argued in its brief that "'praxis' has been extensively registered and used as a trademark on a variety of products," but applicant offered neither testimony nor any other evidence thereof. Further, applicant acknowledged in its brief that "this particular factor may be accorded little weight in the ultimate determination of likelihood of confusion." Applicant simply argues that the registration file histories of opposer's registrations, indicate that other "prior praxis-mark owners contemplated opposing ETS's registration applications." (Brief, p. 23.) Even if applicant had introduced third-party registrations into the record, such registrations would be of little weight in determining likelihood of confusion as they are not evidence of use of the marks shown therein and they are not proof that consumers are familiar with them so as to be accustomed to the existence of similar marks in the marketplace. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Conde Nast Publications, Inc. v.*

American Greetings Corp., 329 F.2d 1012, 141 USPQ 249 (CCPA 1964).

Inasmuch as applicant has not commenced use of its mark, the du Pont factor of actual confusion is not relevant in this case. Applicant's comment that opposer had ample opportunity to conduct consumer surveys regarding potential confusion is unpersuasive. Surveys are not required in Board proceedings which determine the right to register only. See *Hilson Research, Inc. v. Society for Human Resources Management*, 27 USPQ2d 1423, 1435-1436 (TTAB 1993).

Finally, applicant, as the newcomer, has the opportunity of avoiding confusion, and is obligated to do so. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Based on the similarity of opposer's marks and applicant's mark; the relatedness of applicant's computer software, as identified, to both opposer's goods and services; the same trade channels for both parties' goods and services; the similar classes of purchasers; and the strength of opposer's mark; we find that confusion is likely.<sup>16</sup>

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<sup>16</sup> We hasten to add that our decision on likelihood of confusion would be the same, even if opposer's registrations had been cancelled for the International Class 9 goods.

**Opposer's Opposition -- Lack of Bona Fide Intent To Use**

Opposer has not established by a preponderance of the evidence that applicant lacked a bona fide intent to use its mark at the time it filed its application. In fact, this record clearly shows that applicant had a bona fide intent to use the mark, but it did not start the development program for its mark pending the resolution of this trademark dispute. (See, e.g., July 30, 1997 Charles G. Tetro dep., p. 30, and Confidential Exhibits 7 and 9 from the October 26, 1994 Charles G. Tetro discovery dep.)<sup>17</sup> Opposer's argument that applicant did not act to finance and develop the mark is unpersuasive. In the situation present in this case, applicant was justified in putting its development and financing plans for this mark on hold. See *Anderson, Clayton & Co. v. Christie Food Products Inc.*, 4 USPQ2d 1555, 1559 (TTAB 1987).

The legislative history of the Trademark Law Revision Act makes clear that the opposition procedure is intentionally placed prior to when an applicant is required to use a mark in an intent-to-use application. "Subjecting an intent-to-use application to the opposition process

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<sup>17</sup> The 1993 American Vocational Association Convention book lists applicant under the "trade show directory," and the description includes a reference to applicant's PRAXIS program. (Opposer's Exhibit 29, p. 151.) Outside of this use of the term PRAXIS, there is no evidence that applicant has commenced use of the involved mark for the involved goods; and in fact, applicant

before the applicant makes use of its mark is essential if the system is to achieve its goal of reducing uncertainty before the applicant invests in commercial use of the mark." S.Rep. No. 515 at 32, 1988 U.S.C.C.A.N. at 5595. See also Eastman Kodak Co. v. Bell & Howell Document Management Products Co., 994 F.2d 1569, 26 USPQ2d 1912, 1916 (Fed. Cir. 1993).

Opposer's argument that applicant did not have an intent to use the mark exactly as it is applied for (i.e., with all of the words in the exact arrangement and font size, with the Greek letter Y (Xi) as the fourth letter of the word PRAYIS, and always including the words "personal records access and information system") is also not established in the record before us. Applicant's use of the word PRAXIS<sup>18</sup> alone as a shorthand version in applicant's internal documents, including minutes of Board meetings, and even occasional uses in correspondence does not prove that applicant did not have a bona fide intent to use the mark as applied for, especially in light of applicant's decision to

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answered opposer's interrogatory No. 1 that it has not used its applied-for mark anywhere.

<sup>18</sup> In the October 21, 1996 discovery deposition of John Dorrer, applicant's senior vice president, he acknowledged that he had not investigated whether the Greek letter could be displayed in applicant's DOS-based products, but that he thought "probably not." However, he also testified that it was contemplated that applicant's PRAYIS product would be Windows-based. (Dep., p. 18.)

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withhold development of this product until the trademark dispute was determined.

**Decision:** Applicant's counterclaim to cancel the International Class 9 goods in opposer's pleaded Registration Nos. 1,772,125, 1,772,128 and 1,812,590 is denied; and the opposition is sustained on the ground of likelihood of confusion only, and registration to applicant is refused.